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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,899	12/03/2003	Craig L. Adams	21400/0209955-US0	9472
79292 7590 03/06/2009 Boston Scientific Corporation Darby & Darby P.C. P.O. Box 770 Church Street Station New York, NY 10008-0770				
EXAMINER				
FARAH, AHMED M				
ART UNIT		PAPER NUMBER		
3769				
MAIL DATE		DELIVERY MODE		
03/06/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/727,899

**Applicant(s)**

ADAMS ET AL.

**Examiner**

Ahmed M. Farah

**Art Unit**

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Oct. 3, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Berthiaume US Patent No. 5,846,259.

Berthiaume discloses a telescoping catheter adapted for use within a human body, the catheter comprising:

- a proximal end (including fitting **15** and telescoping shaft **70**, see Fig. 1);
- a telescoping section comprising a distal end (including balloon **49**, see Fig. 1);
- a cable extending from the proximal end to the distal end (see the abstract and col. 6, lines 11-37);

- a first sheath (telescoping shaft **60**) coupled to the proximal end, the first sheath extending distally along the cable and substantially surrounding the cable when the catheter is fully retracted (see Figs. 1, 6, and col. 4, line 66 to col. 5, lines 11);

- a second sheath (extension shaft **40**) coupled to the distal end, the second sheath extending proximally from the distal end and substantially surrounding the cable when the catheter is fully retracted (see Fig. 1 and col. 4, lines 11-18), the second

sheath adapted to slideably engage the first sheath so as to extend or retract the catheter (see Fig. 6; col. 6, lines 38-44; and col. 7, lines 16-30); and

a third sheath (guide-wire shaft **30**) coupled to the distal end and located within the second sheath (see Figs. 1, 2 and col. 4, lines 42-53), the third sheath extending proximally along the cable and closely surrounding the cable from the distal end to a point within the first sheath when the catheter is fully extended, the third sheath adapted to slideably engage the first sheath (see Fig. 6; col. 4, lines 54-61; and col. 7, lines 24-30).

**Note:** in this Office Action, the telescoping shaft **60** is treated as the "first sheath" and the extension tube **40** and guide-wire shaft **30** (which is fixedly disposed inside the extension tube **40**) are respectively treated as the "second" and "third" sheaths as claimed. The second sheath (extension tube **40**) and third sheath (guide-wire lumen **30**) are slidably drawn into the first sheath (telescoping tube **60**) by holding the fitting **15** and pulling the inflation shaft **20** (see col. 7, lines 10-37). Hence, the examiner's position is that Berthiaume teaches the recited structure of the instant claims 1 and 2.

With respect to claims 3-5, Berthiaume teaches the third sheath (guide-wire shaft **30**) is made of flexible polymer as claimed (see col. 4, lines 44-53).

With respect to claims 8, 9, and 11, the balloon **49** at the distal end of the catheter has a flush port and is treated as a spacer because it is configured to stop the distal end of the catheter to fully retract into the telescopic sheaths **60** and **70**.

As to claim 10, the spacer (balloon **49**) also includes at least two radially spaced lumens, the inflation lumen of the balloon **49** and the guide-wire lumen **36**.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over f Berthiaume in view of Levy et al. US Patent No. 5,346,489.

Berthiaume, described above, do not teach that the first telescoping shaft **60** engages the extension shaft **40** (2nd sheath) in male relationship, and slides in female relationship with the third sheath (guide-wire shaft 30) as recited in claim 7 and independent claims 12 and 26. However, the use of telescoping catheter shafts engaging in male/female relationships is known in the medical art.

Levy et al. teach a medical device comprising a plurality of telescoping tubes that engage each other in male/female relationships (see Figs. 2-8). Moreover, the applicants admit in the background section of the written description that the use of telescoping catheter, as claimed, is known in the prior art with the exception of telescoping catheter comprising a third (additional) sheath disposed inside the second sheath as claimed.

Therefore, at the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art to modify Berthiaume in view of Levy et al. and change the way in which the telescoping shafts engage each other. The court decided that changing the position of an element known in the art is not patentable, and was held as

an obvious design choice, unless the change modifies the function/operation of said element.

With respect to claims 18 and 19, the use of energy delivery device, such as an optical fiber and/or an electrical conductor, with catheter device to advance said delivery device into a treatment site is well known in the art. Hence, it would have been obvious one skilled in the art to use the catheter of Berthiaume to advance energy deliver device into a treatment site as claimed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M. Farah whose telephone number is (571) 272-4765. The examiner can normally be reached on Mon, Tue, Thur and Fri between 9:30 AM 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johnson Henry can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ahmed M Farah/  
Primary Examiner, Art Unit 3769

January 20, 2009.